

09/364,522

MS136622.1

REMARKS

Claims 1-43 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-2, 8-12, 19-20, 22-25, 26-27, 30-35, and 41-43

Under 35 U.S.C. §103(a)

Claims 1-2, 8-12, 19-20, 22-25, 26-27, 30-35, and 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen, "Learning Rules that Classify E-Mail" 1996 (as disclosed at <http://www-2.cs.cmu.edu/~wcohen/pubs-t.html>) in view of Lewis, "Evaluating and Optimizing Autonomous Text Classification Systems", 1995ACM.

It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Cohen nor Lewis, alone or in combination, teach or suggest applicants' claimed invention let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993).

09/364,522

MS136622.1

Independent claim 1 recites generating priority of a document based on a document classifier. Contrary to the Examiner's assertions, Cohen does not teach generating priority of a document based on a classifier. Rather, Cohen teaches employment of a classifier in connection with "keyword-spotting rulesets" so as to categorize e-mails (see page 1, second column, 3<sup>rd</sup> paragraph of Cohen). Regarding prioritization within the framework of Cohen, this reference simply teaches employing classification rules to place e-mails in proper folders – "A user can be asked ... only when a mailbox has at least  $k$  unread messages, or when the oldest unread message is at least  $d$  days old; thus Ishmail can be used to prioritize unread mail" (see page 5, col. 2 of Cohen). Cohen does not teach or suggest *generating priority of a document based on a document classifier* as recited in claim 1. Rather, Cohen simply teaches using a classifier to categorize e-mails so that they are placed in proper folders, and any mention as to prioritization is not based on a classifier but instead is related to volume or age of e-mail in a folder. Lewis does not make up for the aforementioned deficiencies of Cohen with respect to this claim limitation.

The teachings of Cohen to simply rank a document within a class is not novel as compared to the subject claimed invention which relates to building classifiers that *directly prioritize* documents (e.g., e-mail) as well as generating an urgency value (e.g., given state of user, determined priority of document, predetermined thresholds...) as recited in various dependent claims of the application. More particularly, the claimed invention provides for training classifiers to directly classify incoming content with a priority that can be employed to sort, alert, etc. A classifier in accordance with the subject invention can *directly* determine urgency of communications – a determined urgency score can be a measure of "expected cost of delayed review", which can be weighed against cost of disruption – so as to provide a means for balancing costs and benefits of alerting a user. The score can also be used in an ambient display to list documents in order of priority, and perform functions such as automated opening and/or alerting in connection with the documents as well as relaying of documents based on priority. Neither Cohen nor Lewis, alone or in combination, teach or suggest the above-noted aspects of the claimed invention.

09/364,522

MS136622.1

Moreover, there is no motivation to combine the references in the manner suggested.

The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F.2d at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

Cohen relates to using classifiers in connection with categorizing e-mails via *keyword-spotting rulesets* so as to place respective e-mails in proper folders. Lewis relates to generating text classifications systems. In view of neither reference providing any motivation to be combined in the suggested manner, it appears the Examiner's purported combination of these references is impermissibly based on 20/20 hindsight wherein applicant's specification is being employed as a roadmap to effect the combination.

Independent claims 19 and 26 also recite claim limitations similar to that of independent claim 1.

In view of at least the above, it is respectfully submitted that the combination of Cohen and Lewis do not make obvious the subject invention as recited in independent claims 1, 19 and 26, and claims 2, 8-12, 20, 22-25, 27 and 30-35 which respectively depend there from.

## II. Rejection of Claims 3-7, 21, 28-29, and 37-40 Under 35 U.S.C. §103(a)

Claims 3-7, 21, 28-29, and 37-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen in view of Lewis as applied to claims 1-19, and 26 above and further in view of Henderson, *et al.*, (US 6,185,603B1). Withdrawal of this rejection is respectfully requested for at least the following reasons.

09/364,522

MS136622.1

As discussed *supra* with respect to independent claims 1, 19 and 26 the combination of Cohen and Lewis does not make obvious the subject invention as recited in these claims. Claims 3-7, 21, 28-29, and 37-40 depend from these independent claims, and Henderson does not make up for the aforementioned deficiencies of Cohen and Lewis with respect to the subject independent claims. Accordingly, this rejection should be withdrawn.

**III. Rejection of Claims 13-18 and 36 Under 35 U.S.C. §103(a)**

Claims 13-18, and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen in view of Lewis as applied to claims 1-19, and 26 above and further in view of Platt (US 6,327,581B1).

Independent claim 13 recites similar limitations as discussed *supra* with respect to claims 1, 19 and 26. Accordingly, the aforementioned deficiencies of Cohen and Lewis apply to this claim as well. Moreover, it is noted that claim 13 recites a Bayesian classifier, and Cohen teaches away from employment of such type of classifier – “[I]t should be noted that these rulesets are quite different from the classifiers constructed by more common text categorization learning methods, such as naïve Bayes...” (see page 1, col. 2 of Cohen). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In view of the above, this rejection of claim 13 and claims 14-18 should be withdrawn.

Claim 36 depends from independent claim 26, and Platt does not make up for the above-noted deficiencies of Cohen and Lewis with respect to claim 26. Accordingly, this rejection should be withdrawn.

09/364,522

MS136622.1

**IV. Conclusion**


The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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